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PTO/SB/17 (10-08)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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FEE TRANSMITTAL For FY 2009		Complete if Known	
<i>Effective on 12/08/2004.</i> <i>Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</i>		Application Number	10/815,016-Conf. #9225
		Filing Date	March 31, 2004
		First Named Inventor	Ellen Glassman
		Examiner Name	N. Chowdhury
		Art Unit	2621
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No. SOA-0387	
TOTAL AMOUNT OF PAYMENT		(\$) 540.00	

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____
 Deposit Account Deposit Account Number: 18-0013 Deposit Account Name: Rader, Fishman & Grauer PLLC

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee
 Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 Credit any overpayments

FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

<u>Application Type</u>	<u>FILING FEES</u>		<u>SEARCH FEES</u>		<u>EXAMINATION FEES</u>		<u>Fees Paid (\$)</u>
	<u>Fee (\$)</u>	<u>Small Entity</u>	<u>Fee (\$)</u>	<u>Small Entity</u>	<u>Fee (\$)</u>	<u>Small Entity</u>	
Utility	330	165	540	270	220	110	
Design	220	110	100	50	140	70	
Plant	220	110	330	165	170	85	
Reissue	330	165	540	270	650	325	
Provisional	220	110	0	0	0	0	

2. EXCESS CLAIM FEESFee Description

Each claim over 20 (including Reissues)

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Small Entity</u>	<u>Fee (\$)</u>	<u>Fee (\$)</u>
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52 26

Each independent claim over 3 (including Reissues)

220 110

Multiple dependent claims

390 195

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>
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<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
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- or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
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<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
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- or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
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- 100 = _____ /50 = _____ (round up to a whole number) x _____ = _____

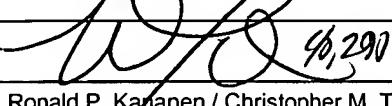
<u>Fees Paid (\$)</u>

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal

540.00

SUBMITTED BY						
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Name (Print/Type)	Ronald P. Kallanen / Christopher M. Tobin			Date	November 18, 2008	





TRANSMITTAL OF APPEAL BRIEF		Docket No. SOA-0387
In re Application of: Ellen Glassman et al.		
Application No. 10/815,016-Conf. #9225	Filing Date March 31, 2004	Examiner N. Chowdhury
Invention: METHODS AND APPARATUSES FOR DISPLAYING CONTENT THROUGH A STORAGE DEVICE		
<u>TO THE COMMISSIONER OF PATENTS:</u>		
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>September 21, 2008</u> .		
The fee for filing this Appeal Brief is <u>\$ 540.00</u> .		
<input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity		
<input type="checkbox"/> A petition for extension of time is also enclosed.		
The fee for the extension of time is _____.		
<input type="checkbox"/> A check in the amount of _____ is enclosed.		
<input checked="" type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>18-0013</u> . This sheet is submitted in duplicate.		
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.		
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>18-0013</u> . This sheet is submitted in duplicate.		
 Ronald P. Kananen / Christopher M. Tobin Attorney Reg. No. 24,104 / 40,290 RADER, FISHMAN & GRAUER PLLC 1233 20th Street, N.W. Suite 501 Washington, DC 20036 (202) 955-3750		Dated: <u>November 18, 2008</u>



Docket No.: SOA-0387
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ellen Glassman et al.

Application No.: 10/815,016

Confirmation No.: 9225

Filed: March 31, 2004

Art Unit: 2621

For: METHODS AND APPARATUSES FOR
DISPLAYING CONTENT THROUGH A
STORAGE DEVICE

Examiner: N. Chowdhury

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on October 21, 2008, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

11/19/2008 SHOHAMME 00000019 180013 10815016
01 FC:1401 540.00 DA

11/19/2008 SHOHAMME 00000029 180013 10815016
01 FC:1402 540.00 DA

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- Appendix A Claims
- Appendix B Evidence
- Appendix C Related Proceedings

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Sony Corporation of Tokyo, Japan; and

Sony Electronics Inc. of Park Ridge, New Jersey

An assignment of interest in the present application was filed and can be found on reel/frame 016911/0383

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 23 claims pending in this application.

B. Current Status of Claims

1. Claims canceled: 2, 5-6, 10-21, and 30
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1,3,4,7-9,22-29, and 31-39
4. Claims allowed: none
5. Claims rejected: all

C. Claims On Appeal

The claims on appeal are claims 1, 3, 4, 7-9, 22-29, and 31-39

IV. STATUS OF AMENDMENTS

Appellant filed an Amendment After Final Rejection on August 29, 2008. The Examiner responded to the Amendment After Final Rejection in an Advisory Action mailed October 2, 2008. In the Advisory Action, the Examiner indicated that Appellants' proposed amendments would not be entered.

Accordingly, the claims enclosed herein as Appendix A incorporate the amendments indicated in the response filed by Appellant on March 12, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed to a method including storing content (Fig. 5, el. 510) on a portable memory device (Fig. 6, 7, el. 600, 700), said content including an image captured using a recorder/playback device (Fig. 6, 7, el. 610, 710); detaching the portable memory device from the recorder/playback device, thereby providing access to a secondary user interface (Fig. 7, el. 760) on the recorder/playback device that is inaccessible when the portable memory device is attached;

displaying the image on the portable memory device (Fig. 5, el. 540) while the portable memory device is detached from the recorder/playback device (p. 14, ll. 10-12, p. 31, ll. 17-20); and displaying functional controls (p.14, l. 14) for the recorder/playback device while the portable memory device is connected to the recorder/playback device.

As per claim 23, the portable memory device may be configured to include an attachment area (Fig. 6, 7, el. 640, 740), said attachment area including a magnet for attaching the portable memory device to a metallic object, such that the portable memory device displays the image while attached to the metallic object (p. 16, ll. 17-23).

As per claim 35, the recorder/playback device may include a second display which is part of the secondary user interface (Fig. 7, el. 760 “camera display”), and the secondary user interface may be positioned underneath portable memory device when the portable memory device is attached (Fig. 7).

Claim 24 is directed to a portable imaging system (Fig. 6, 7), comprising: a portable memory device (Fig. 6, 7, el. 600, 700) coupled to a recorder/playback device (Fig. 6, 7, el. 610, 710). The portable memory device includes interface means (Fig. 6, 7, el. 640, 740) for connecting to and detaching from a recorder/playback device; storage means (Fig. 4, el. 400) for storing content including an image captured using the recorder/playback device; display means (Fig. 6, 7, el. 620, 720) for displaying the image while the portable memory system is detached from the recorder/playback device; and the display means is configured to display functional controls (p.14, l. 14) for the recorder/playback device while the portable memory device is connected to the recorder/playback device. The recorder/playback device includes an image capture device (Fig. 7, el. 750 “digital camera” “camera attachment”); a secondary user interface (Fig. 7, el. 760) that is inaccessible when the portable memory device is attached, that becomes accessible when the portable memory device is detached. As per claim 24, the portable memory device includes an attachment area (Fig. 6, 7, el. 640, 740), including a magnet for attaching the portable memory system to a metallic object, such that the display means displays the image while the portable memory system is attached to the metallic object (p. 16, ll. 17-23).

As per claim 36 and 37, the portable imaging system of claim 24, wherein the secondary user interface may include a second display 760 and function keys (Fig. 7, note two buttons on recorder 710, below display 760, p. 17, l. 20) positioned underneath the portable memory device, when the portable memory device is attached.

Claim 31 is directed to a portable imaging device including a portable memory device (Fig. 6, 7, el. 600, 700) coupled to a recorder/playback device (Fig. 6, 7, el. 610, 710). The portable memory device includes an interface (Fig. 6, 7, el. 640, 740), which connects to and detaches from a recorder/playback device; a memory (Fig. 4, el. 400), in operative communication with the interface, which stores content including an image captured using the recorder/playback device; and a display (Fig. 6, 7, el. 620, 720), in operative communication with the memory, which displays the image while the portable memory device is detached from the recorder/playback device. The display is configured to display functional controls (p.14, l. 14) for the recorder/playback device while the portable memory device is connected to the recorder/playback device. The recorder/playback device includes an image capture device (Fig. 7, el. 750 “digital camera” “camera attachment”); a secondary user interface (Fig. 7, el. 760) that is inaccessible when the portable memory device is attached, but becomes accessible when the portable memory device is detached. As per claim 33, the portable device may include an attachment area (Fig. 6, 7, el. 640, 740), including a magnet for attaching the portable memory system to a metallic object, such that the display means displays the image while the portable memory system is attached to the metallic object.

As per claim 38 and 39, the secondary user interface may include a second display 760 and function keys (Fig. 7, note two buttons on recorder 710, below display 760, p. 17, l. 20) positioned underneath the portable memory device, when the portable memory device is attached, and inaccessible and positioned underneath the portable memory device when the portable memory device is attached to the portable recorder/playback device.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether the Examiner erroneously rejected claims 1, 3, 4, 7-10, 12, and 22-33 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,757,479 to Niikawa (“Niikawa”) in view of U.S. Patent No. 6,329,787 to Ito et al. (“Ito”), in further view of U.S. Patent Pub. 2007/0271508 to Audet (“Audet”) and U.S. Patent No. 6,577,811 to Kikuchi et al. (“Kikuchi”).

VII. ARGUMENT

The Examiner erroneously rejected claims 1, 3, 4, 7-10, 12, and 22-33 under 35 U.S.C. § 103(a) over Niikawa in combination with Ito, Audet, and Kikuchi.

Niikawa discloses an image display device that accommodates browsing through image files. Although figure 2 mentions a portable memory device 8, this is a conventional portable memory device (*e.g.*, a flash drive, floppy disk, etc.) that does not include a display. Additionally, portable memory device 8 is separate from the display device 1.

FIG. 1

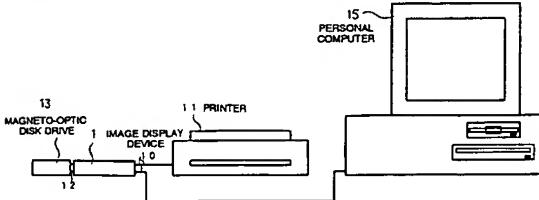
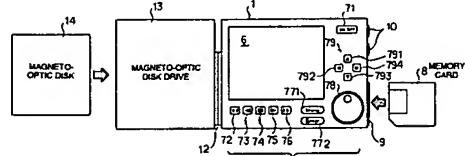


FIG. 2



Thus, Niikawa merely discloses a conventional portable memory device 8, which may be inserted into a reading apparatus, such as the image display device 1.

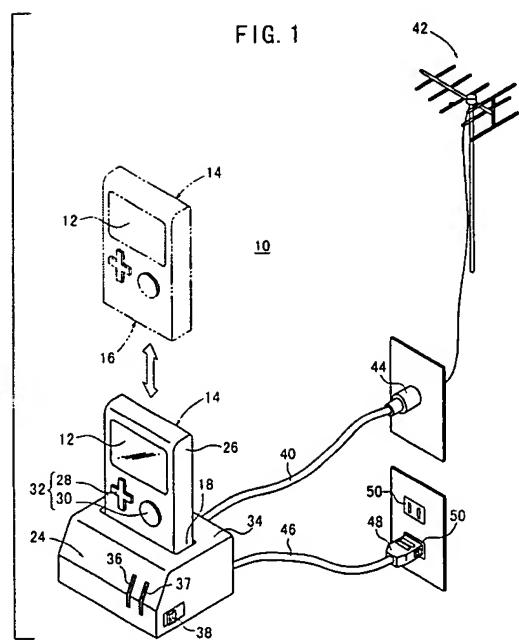
Also, particularly evident is the fact that the Niikawa device is not portable, but is instead a combination of components, including a personal computer 15, printer 11, and disk drive 13, designed to operate as a video editing workstation. Furthermore, there is no particular motivation to provide image display capabilities to the magnetic optical disc.

Ito discloses a portable digital media viewing device for viewing pictures, images, sounds, video, etc. (column 5, lines 25-30). Fig.1 illustrates portable device 14 having display 12 and controls 32. A battery-charging device 24 charges portable device 14. Charging device 24 connects to a power source 50 and a data source 44 (or 147, in Fig. 5). Fig. 3 illustrates the charging process for portable device 14. Prior to mounting portable device 14 onto charging device 24, a user selects the content that charging device 24 will provide portable device 14 (step 2; column 6, lines 51-56). After mounting portable device 14 onto charging device 24, charging device 24 serves the dual purpose of charging (step S4) and providing digital content for transfer and storage on portable device 14 (steps S8-S9).

Ito does not provide or suggest any device for controlling the recording or capture of digital content, nor does Ito suggest displaying control information while the portable viewer is connected to the charger. Furthermore, Ito does not provide any basis for separating the functionality of the disclosed device into two detachable components.

Ito clearly employs a device that houses all the user functional components into a single package, i.e., portable device 14. There is no reason given by Ito or Niikawa for providing a device having two interface components, e.g., on both a memory component and a recording component. The device operates as a single device via a single interface.

Audet is a continuation-in-part of Parent Application No. 11/693,669, filed on March 29, 2007. The parent Application is itself a continuation-in-part of Grandparent Application 10/265,443, filed on October 7, 2002. Audet only qualifies as prior art to the extent that the cited material in Audet is disclosed in Grandparent Application 10/265,443 (Patent Pub. 2007/0214169).



Appellant is unaware why the Examiner chose to use the grandchild application as the basis for the present rejection. However, The Examiner did choose to cite to large portions of the grandchild application that are completely absent from the Grandparent Application 10/265,443 (Patent Pub. 2007/0214169), including a section titled “*Other uses of the SMLOI*” which is nonexistent in the Grandparent Application 10/265,443, and refers to figures not provided in the Grandparent Application.

The Examiner cites to Fig. 6 of Audet, which illustrates a hardware and software computer system, including multiple peripheral components including an image capture device 100, and claims to include a touch screen (not shown). The examiner cites the “touchpad” as the basis for rejecting the “functional controls” that is “inaccessible and positioned underneath the portable memory device when the portable memory device is attached to the portable recorder/playback device”.

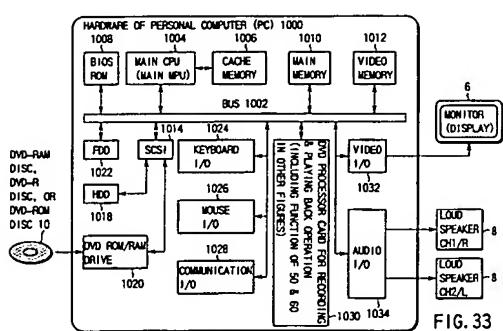
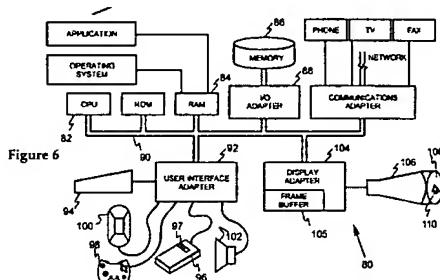


FIG. 33

Kikuchi discloses a contents protections method for digital recordings, such as DVDs. Fig. 33 (cited in the Final Office Action) illustrates a personal computer 1000 having a DVD-ROM 1020 and display 6. The Examiner argues that “Kikuchi discloses providing access to a secondary user interface on the recorder/playback device (DVD digital video recorder or PC (fig. 33)) that is

inaccessible when the portable memory device is attached (col. 67 lines 57-65)." However, What Kikuchi discloses is actually that the DVD playback is not performed when the DVD is unreadable.

A. Independent claims 1, 24, and 31

In setting forth the Final Rejection, the Examiner grouped independent claims 1, 24, and 31. Therefore, these claims are argued together, with claim 24 as the representative claim.

In part, claim 24 recites:

A portable imaging system, comprising:

a portable memory device coupled to a recorder/playback device;

the portable memory device comprising:

display means ...

the display means is configured to display functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device, and

the recorder/playback device comprising:

a secondary user interface that is inaccessible when the portable memory device is attached, that becomes accessible when the portable memory device is detached.

Claim 24 recites two control mechanisms for controlling the *recorder/playback device*: “*display means* [,on the portable memory device,] *configured to display functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device,*” and “*a secondary user interface that is inaccessible when the portable memory device is attached, that becomes accessible when the portable memory device is detached.*” These two control mechanisms provide controls for the *recorder/playback device* when *the portable memory device is connected* and *when the portable memory device is detached*. Furthermore, the control mechanisms are mutually exclusive, because *display means* on the portable memory device is *configured to display functional controls for the recorder/playback device while the portable memory device is connected*, and the *secondary user interface is inaccessible when the portable memory device is attached*. In this sense, the interfaces are complimentary, offering the user alternative mechanisms to control the *recorder/playback device* whether the memory device is *connected* or *detached*.

Niikawa merely discloses a conventional portable memory storage device used on a video editing workstation. There is a video editing interface that is accessible but unusable until the memory device is attached. However, there is no basis for providing two mechanisms for any associated *recorder/playback device*; particularly, there is no basis for providing a mechanism to control a *recorder/playback device on the memory device*.

Ito does not remedy the deficiencies of Niikawa.

At best, Ito discloses that some functionality exists on the *portable digital media viewing device*, when the portable digital media viewing device is detached.

However, Ito does not disclose that any functionality becomes available on the charging device when the portable digital media viewing device is detached, or that any functionality become available on the portable digital media viewing device when the device is connected to the charger. Finally, Ito does not provide for any functionality or interface pertaining to a *recorder/playback device* or controlling such a device.

Audet does not remedy the deficiencies of Niikawa and Ito.

Audet only provides a mechanism for communicating new organization structures and methods of traversing data to a user. Audet is simply cited for the purpose of providing an example of a touch pad interface. Audet does not provide for a mechanism having two complimentary interfaces, but only provides an example of a common workstation, where a camera is attached to a system having a user interface. Audet does not disclose a particular mechanism having the claimed features cited above.

Kikuchi does not make up for the deficiencies of Niikawa, Ito, and Audet.

While Kikuchi explains that a DVD playback interface would fail to operate if the DVD provided is broken or incompatible with the system, this is very different than arguing that the disclosed memory device (DVD) makes an interface inaccessible, while providing an alternative interface.

The claim recites, in the alternative, that the two claimed control mechanisms provide controls for the *recorder/playback device* when *the portable memory device is connected* and *when the portable memory device is detached*. Kikuchi does not address the issue of whether the memory

device is detached or not, it simply addresses the obvious condition that playback is impossible if the DVD is unusable.

Appellant submits that, even if Niikawa, Ito, Audet, and Kikuchi were combinable (which is not admitted), the combination would fail to teach or suggest two control mechanisms for controlling the *recorder/playback device* via a, “*display means [on the memory device,] configured to display functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device,*” and “*a secondary user interface that is inaccessible when the portable memory device is attached, that becomes accessible when the portable memory device is detached.*” The disclosed devices and systems in Niikawa (*i.e.*, a multi-component image capture and editing workstation) and Ito (*i.e.*, a portable digital media device) and Audet (*i.e.*, a data organization and traversal system) and Kikuchi (a simple DVD playback device) would not prompt one of ordinary skill, and indeed the Office Action provides no evidence whatsoever to support, a conclusion that it would have been obvious to the ordinarily skilled artisan, to create a device having the control mechanisms that are only accessible when memory is removed on recorder device, and on the memory device when the memory device is connected to the recorder.

Even if Niikawa, Ito, Audet, and Kikuchi were combinable (which is not admitted), the combination would lead to a video editing workstation, that reads data from a portable device, with some kind of display interface for viewing data on the device. There is no basis for arguing that the combination would lead to a display on the memory device capable of controlling a camera on the workstation or another device.

Since even a combination of the relied upon references would still fail to yield the claimed invention, Appellant submits that a *prima facie* case of obviousness for claim 1, 24, and 31 has not been presented.

Dependent claims 3, 4, 7-9, 22-23, 25-30, and 32-39 incorporate the features recited in independent claims 1, 24, or 31 and thus are not suggested by the combination of Niikawa, Ito, Audet, and Kikuchi.

B. Dependent claims 23, 26 , 32, and 33

Claims 23 and 32 have been rejected under identical arguments.

Claim 23 recites:

The method of Claim 1, wherein the portable memory device is configured to include an attachment area, said attachment area including a magnet for attaching the portable memory device to a metallic object, such that the portable memory device displays the image while attached to the metallic object.

Claim 23 recites “*wherein the portable memory device is configured to include an attachment area, said attachment area including a magnet for attaching the portable memory device to a metallic object, such that the portable memory device displays the image while attached to the metallic object*”.

The Examiner rejected claim 23 by taking official notice that using magnets to attach metallic devices is known. Appellant objects generally to the examiner’s taking of official notice, and in particular notes that the examiner fails to identify that using magnets to attach “portable memory devices” is “known in the art” by anything beyond mere conjecture and conclusory statements.

“Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp*

Monarch Co., 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).”

MPEP § 2144.03 (A)

The Examiner has failed to provide any “known” examples where magnets are used to connect memory devices. Appellant submits that the use of magnets to attach a memory device is not obvious due to the need to prevent damage to the memory device from the magnetic device. For similar reasons, claims 26 and 33 are not disclosed.

Despite the Appellant’s prior objection to the use of Official Notice in the response to the Office Action of February 12, 2007, no justifiable argument or Examiner signed affidavit has been provided.

C. Dependent claims 35-39

Dependent claims 35-39 were rejected using similar logic; in particular, the Examiner cites to Fig. 27 of Kikuchi to reject these claims. Claim 36 is argued as representative of these claims.

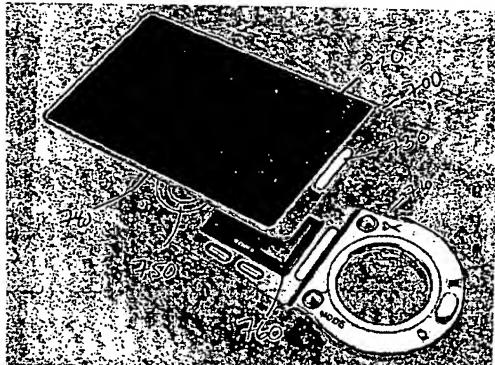
In part, claim 36 recites:

The portable imaging system of claim 24, wherein the secondary user interface includes function keys positioned underneath the portable memory device, when the portable memory device is attached.

The Examiner argues that the subject matter of claim 36 is obvious in view of Kikuchi (Fig. 27), asserting that “Kikuchi discloses the method further comprising displaying a second image on a second display (fig. 26 (46, 48)), the second display being a part of the secondary user interface, and wherein the user interface is positioned underneath portable memory device when the portable memory device is attached (fig. 26-27, col. 30 lines 8-col. 31 lines 20, user can change setting of a DVD digital video recorder (fig. 27 (200)), the way they want, user interface (operation control keys) can be positioned underneath portable memory device (DVD (202)) or vice versa).”

First, claim 36 recites “*function keys positioned underneath the portable memory device, when the portable memory device is attached.*”

In this case, the Examiner’s interpretation of the claims completely contradicts the language of the specification and the claims themselves. While the Examiner is entitled to give the claims their broadest reasonable meaning, this meaning must be subject to a reasonable interpretation in light of the specification.



The specification illustrates a secondary interface positioned underneath the memory device (Appellant’s Fig. 7, left), where element 760 represents the secondary interface on recorder 710.

In this case, the claims clearly set out two requirements for the secondary interface: (1) from claim 24, it must be “*inaccessible when the portable memory device is attached*”; and (ii) from claim 36, it must have “*function keys positioned underneath the portable memory device, when the portable memory device is attached.*”

The interface cited by the Examiner fails to meet either of these requirements. The Examiner cited to Fig. 26 of Kikuchi (right), which illustrates a device having an interface to the right and below the disc tray inlet. First, the identified interface cannot qualify as being “*inaccessible when the portable memory device is attached.*” It may not function, but it is definitely accessible.

Second, while a portion of the interface is positioned below the disc tray, it is not located underneath the portable memory device.

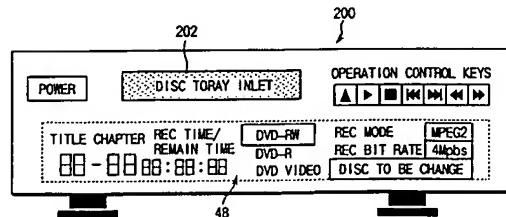


FIG. 27

Furthermore, even if taken beyond reasonable interpretation, the controls, i.e., “operation control keys,” are not positioned below the disc tray, but adjacent to it.

Finally, Kikuchi fails to disclose a secondary user interface, only a single user interface.

Accordingly, Kikuchi does not make up for the deficiencies of Niikawa, Ito, and Audet with respect to claims 35-39.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Appellant on August 29, 2008.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132, or additional evidence entered by or relied upon by the Examiner is being submitted.

X. RELATED PROCEEDINGS

No related proceedings are referenced in section II above, or copies of decisions in related proceedings are not provided.

CONCLUSION

Appellant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SOA-0387 from which the undersigned is authorized to draw.

Dated: November 18, 2008

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/815,016

1. A method comprising:

 storing content on a portable memory device, said content including an image captured using a recorder/playback device;
 detaching the portable memory device from the recorder/playback device, thereby providing access to a secondary user interface on the recorder/playback device that is inaccessible when the portable memory device is attached;
 displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device; and
 displaying functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device.

3. The method according to Claim 1 further comprising transmitting the content from the recorder/playback device to the portable memory device.

4. The method according to Claim 1 further comprising selecting the image for display on the portable memory device.

7. The method according to Claim 1 further comprising selecting a mode to display the image, wherein the mode includes displaying the image as part of sequentially displaying multiple pieces of content.

8. The method according to Claim 1 further comprising selecting a mode to display the image, wherein the mode includes displaying the image as part of simultaneously displaying multiple pieces of content.

9. The method according to Claim 1 wherein the recorder/playback device is one of a digital camera, a video camera, an audio recorder/player, a computer, or a television.

22. The method of Claim 1, wherein said functional controls include soft keys that are particular to the recorder/playback device.

23. The method of Claim 1, wherein the portable memory device is configured to include an attachment area, said attachment area including a magnet for attaching the portable memory device to a metallic object, such that the portable memory device displays the image while attached to the metallic object.

24. A portable imaging system, comprising:

a portable memory device coupled to a recorder/playback device;

the portable memory device comprising:

interface means for connecting to and detaching from a recorder/playback device;

storage means for storing content including an image captured using the

recorder/playback device;

display means for displaying the image while the portable memory system is detached from the recorder/playback device; and

the display means is configured to display functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device, and

the recorder/playback device comprising:

an image capture device;

a secondary user interface that is inaccessible when the portable memory device is attached, that becomes accessible when the portable memory device is detached.

25. The portable memory system of Claim 24, wherein said functional controls include soft keys that are particular to the recorder/playback device.

26. The portable memory system of Claim 24, further comprising:
an attachment area, including a magnet for attaching the portable memory system to
a metallic object, such that the display means displays the image while the portable memory
system is attached to the metallic object.

27. The portable memory system of Claim 24, wherein the interface means connects to
and detaches from the recorder/playback device via a wireless connection.

28. The portable memory system of Claim 24, wherein the image is displayed as part of
sequentially displaying multiple pieces of content.

29. The portable memory system of Claim 24, wherein the recorder/playback device is
one of a digital camera and a computer.

31. A portable imaging device, the portable imaging device comprising:
a portable memory device coupled to a recorder/playback device;
the portable memory device comprising:
an interface, which connects to and detaches from a recorder/playback device;
a memory, in operative communication with the interface, which stores content
including an image captured using the recorder/playback device; and
a display, in operative communication with the memory, which displays the
image while the portable memory device is detached from the recorder/playback
device; and
the display is configured to display functional controls for the recorder/playback
device while the portable memory device is connected to the recorder/playback
device, and
the recorder/playback device comprising:
an image capture device;

a secondary user interface that is inaccessible when the portable memory device is attached, but becomes accessible when the portable memory device is detached.

32. The portable memory device of Claim 31, wherein said functional controls include soft keys that are particular to the recorder/playback device.

33. The portable memory device of Claim 31, further comprising: an attachment area, including a magnet for attaching the portable memory system to a metallic object, such that the display means displays the image while the portable memory system is attached to the metallic object.

34. The method according to Claim 1, further comprising storing content on an internal memory in the portable recorder/playback device, said content including a second image captured using a portable recorder/playback device, when said portable memory device is detached from the portable recorder/playback device.

35. The method according to Claim 1, further comprising displaying a second image on a second display, the second display being a part of the secondary user interface, and wherein the user interface is positioned underneath portable memory device when the portable memory device is attached.

36. The portable imaging system of claim 24, wherein the secondary user interface includes function keys positioned underneath the portable memory device, when the portable memory device is attached.

37. The portable imaging system of claim 24, further wherein the secondary user interface includes a second display that is accessible when the portable memory device is detached from the portable recorder/playback device, and inaccessible and positioned underneath the portable

memory device when the portable memory device is attached to the portable recorder/playback device.

38. The portable imaging system of claim 31, wherein the secondary user interface includes function keys positioned underneath the portable memory device, when the portable memory device is attached.

39. The portable imaging system of claim 31, wherein the secondary user interface includes a second display that is accessible when the portable memory device is detached to the portable recorder/playback device, and inaccessible and positioned underneath the portable memory device when the portable memory device is attached to the portable recorder/playback device.

APPENDIX B – ADDITIONAL EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C – RELATED PROCEEDINGS

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.